

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

33836.00.0028

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Typed or printed name Evelyn Stenseth

Application Number

09/817,917

Filed

March 26, 2001

First Named Inventor

Sanjay Mathur, et al.

Art Unit

2143

Examiner

Kyung H. Shin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 38,566☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Signature

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April 17, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Sanjay Mathur et al.	Examiner:	Kyung H. Shin
Serial No.:	09/817,917	Art Unit:	2143
Filing Date:	March 26, 2001	Docket No.:	05222.00109
Confirmation No.:	8131	Atty. File No.:	33836.00.0028

Title: **METHODS AND APPARATUS FOR PROCESSING DATA IN A
CONTENT NETWORK**

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicants are filing this paper concurrently with a Pre-Appeal Brief Request For Review form PTO/SB/33 and a Notice of Appeal. Applicants respectfully submits that the Examiner's rejections include clear errors because numerous arguments previously presented by Applicants have not been answered by Examiner. Claims 1, 2, 6-21 and 25-33 are currently pending.

Briefly stated, the present invention is directed to techniques for more fully realizing value inherent in so-called content networks, i.e., networks not defined so much by their physical configuration, but rather by the relevance of the data handled therein to a single entity (page 1, lines 11-15; page 2, lines 4-7), by making data within such content networks more readily available to third-parties. To this end, various techniques are generally disclosed for the creation and delivery of "enhanced data" in which domain- and intended use-specific contextual information is associated with discrete components of data.

Turning to the currently-pending Office Action dated January 7, 2007 (mailed January 17, 2007), Applicant notes that the rejections of the claims are a near-verbatim repetition of the previous grounds of rejection set forth in the Office Action dated July 7, 2006 (mailed July 18,

2006). In this regard, Applicants note the instruction of M.P.E.P. §707.07(f) stating that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” However, contrary to this instruction, Applicants respectfully submit that the currently-pending Office Action fails to respond to several arguments previously set forth by Applicants. Because Applicants believe that these arguments establish the patentability of the various claims, failure to consider them constitutes clear error.

With regard to claims 1 and 10, in Applicant’s response filed October 12, 2006, on pages 10-12, Applicants argued that the cited combination of references failed to teach or suggest the claimed limitation of “contextual information . . . associated with the at least one domain and comprising attributes of the at least one discrete component of data relating to an **intended use** of the at least one discrete component of data.” (emphasis added) Indeed, Applicants arguments detailed why the cited portions of the Schaffer reference did not, in fact, teach this limitation. In Section 3.1 of the current Office Action, this particular argument is quoted but no response to it is provided. That is, the response recites various teachings of the Schaffer reference alleged to teach various ones of the claim limitations (e.g., “discrete component of data”, “contextual information”, “at least one domain”) but fails to make any mention where either of the cited references describes or suggests contextual information relating to an intended use of the discrete component of data.

With regard to claim 7, in Applicant’s response filed October 12, 2006, on page 13, Applicants argued that the cited combination of references failed to teach or suggest the claimed limitation of modifying enhanced content based on feedback data. In Section 3.1 of the current Office Action, Examiner has once again quoted this argument but failed to respond to it. The response describes how the cited references allegedly disclose the use of feedback information in

the “combination and generation of enhanced content”, but are wholly devoid of any response to the modification of enhanced content based on the alleged feedback data.

With regard to claims 12, 14 and 15, in Applicant’s response filed October 12, 2006, on pages 16-18, Applicants presented various arguments that the current Office Actions fails to respond to and, indeed, fails to even mention. In particular, with regard to claim 12, Applicants argued that the analogies drawn by Examiner between the various claim elements and the teachings in Schaffer and Alexander references are contradictory and, in any event, that the cited combination of references were unsupported by any statement of a motivation to combine. With regard to claim 14, Applicants argued that the cited references failed to teach, in contrast to the recited limitations, how feedback would be provided, much less that feedback rules are sent to the requestor of enhanced data. Similarly, concerning claim 15, Applicants argued that the cited references failed to teach, in contrast to the recited limitations, that the feedback rules comprise an incentive for the requestor of enhanced data to provide feedback.

With regard to claims 16 and 29, in Applicant’s response filed October 12, 2006, on pages 18, 19 and 22, Applicants argued that because the teachings of Schaffer were misinterpreted, the alleged motivation to combine is vitiated. In Section 3.5 of the current Office Action, no mention of this argument concerning the motivation to combine is given and, instead, simply asserts that the cited combination of references discloses the discovery and negotiation of services.

With regard to claim 33, in Applicant’s response filed October 12, 2006, on page 24, Applicants argued that the cited portions of the Schaffer reference concerning the claimed translation of each of the discrete components in fact failed to teach this limitation. However, Section 3.7 of the current Office Action, while addressing another argument made by Applicants


in support of claim 33, fails to mention, much less respond to, the argument concerning the lack of a "translation" teaching.

Finally, regarding the various other responses provided by the Examiner to Applicants' arguments, Applicants reserve the right to traverse these matters and have refrained from doing so here only because the deficiencies of the current Office Action detailed above fail to provide Applicant with a complete prosecution record upon which further appeal may be based.

Reconsideration and withdrawal of the rejection of the claims and subsequent issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,

Date: April 17, 2007

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